

REMARKS

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Claims 1-3, 5-7, 16, 19 and 20 have been amended to correct minor informalities.

The specification has been amended, as indicated above, to correct minor informalities. No new matter has been added.

Reconsideration of the Claims is respectfully requested.

1. Oath/Declaration

The Office Action recites that the Oath/Declaration submitted with the non-provisional application is required to identify the application number and filing date of the provisional application that priority is claimed, per 35 U.S.C. § 119(e). Applicant respectfully submits that Section 119(e) does not support such a requirement, and that the Oath/Declaration as submitted satisfies the statutory requirements regarding conversion of a provisional application to a non-provisional application. Applicant respectfully requests the benefit of its earlier filed provisional application as permitted under the Patent Act.

Section 119(e) recites that a provisional application “shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title [for provisional applications], if the application for patent filed under section 111(a) [for non-provisional applications] . . . is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application.” 35 U.S.C. § 119(e)(1).

The non-provisional application was filed within 12 months after the date on which the provisional was filed, and contains a specific reference to the provisional application. (*see* Application, page 1, *ll.* 6-8). The non-provisional application was filed with the oath or declaration pursuant to 37 C.F.R. § 1.63. *See* MPEP § 601.01(d), p. 600-11 (rev 2, May 2004). Further, *in arguendo*, the non-provisional application incorporates the

provisional application, and the inventors state that they “have reviewed and understand the contents of the application titled ‘Method and Apparatus for a Hybrid Mobile Terminal.’” (*see* Declaration).

Accordingly, Applicant respectfully submits that it has complied with the statutory and regulatory requirements regarding conversion of its provisional application to a non-provisional application, and is entitled to claim the priority date set out by the provisional application.

2. Rejection under 35 U.S.C. § 103(a)

(a) Claims 1-2, 4-5, 8-10, 12-16 and 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilchrist et al., U.S. 5,745,695 (“Gilchrist”), and further in view of Hays WO95-26113 (“Hays”).

Applicant traverses these rejections and requests reconsideration of its claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP § 2142, p. 2100-128 (Rev. 2, May 2004).

Gilchrist recites that “[t]hree classes of GPRS mobile stations [that] are contemplated: Classes A, B, and C. These classes reflect certain capabilities that a customer accepts through the purchase of the equipment.” (Gilchrist, col. 1:27-30). “Because of their nature, Classes B and C [Mobile Stations] give rise to unique service integration problems.” (Gilchrist, col. 1:33-35). The class B Mobile Station receives “paging requests with the same probability as if it were only operating in idle mode procedures.” (Gilchrist, col. 1:37-39). The “class C [Mobile Station] . . . cannot be interrupted.” (Gilchrist, col. 1:46-48).

Hays recites providing “benefits and improvements in the provision of cellular data transmission in AMPS, CDPD, GSM, and other modes, which benefits and improvements include, but are not limited to: power savings and concomitant increased battery life between recharges; increased coverage, even where cellular coverage may be absent, incomplete or unreliable; increased building penetration; seamless nationwide and international roaming capabilities; enhanced service options and subscriber profiling/screening/filtering options providing least-cost-routing capabilities and economies; and ‘connectionless’ broadcast services and resultant economies.” (Hays p. 3, *ll.* 29-36, p. 4, *ll.* 1-3).. In Hays, the “cellular digital data processing unit [of the mobile phone 20] . . . processes digital data received from the mobile cellular telephone 214 via a cellular channel and processes digital data to be sent to mobile cellular telephone 214 [of the mobile phone 20] to be transmitted via a cellular channel.” (Hays p. 7, *ll.* 12-17). In other words, Hays relates to the network access capability to the mobile phone, which has a mobile cellular telephone 214 (*see* Hays p. 7, *l.* 13) and a pager 21 (*see* Hays p. 7, *l.* 31).”

In contrast, Applicant’s claimed invention recites, *inter alia*, an “access network controller comprising . . . a memory for storing computer instructions that define operational logic relating to a response of the access network controller to a received pseudo-page signal” (Independent Claim 1). Recited also is a method “in a communication network, comprising: receiving a pseudo-page signal transmitted by a base station in a specified interface signal between the base station and an access network controller; and generating a corresponding response.” (Independent Claim 8). As explained in Applicant’s specification, the pseudo-page signal “is a signal that prompts the [Access Network Controller] to produce a response signal 144 that allows the [Base Station Controller] to determine how to process a call if the [Hybrid Mobile Station] is presently engaged in a data call.” (Page 8, *ll.* 23-26; *see also* Page 4, *ll.* 9-12) (“[T]he base station (BSC/BTS) is formed to generate a signal to the access network controller, referenced herein as a pseudo-page signal, to determine whether the hybrid mobile station is present and available.).

The Office Action recites that “Figure 4 [of Gilchrist] shows a Paging Request #201/#202 and Gilchrist also discloses logic that would be used when the mobile is busy, that is, bar all incoming calls, call forward, etc. [(Gilchrist, col. 4:9-17)]” (Office Action, p. 3, ¶ 3). But the class C mobile station of Gilchrist is not capable of being interrupted. (Gilchrist, col. 1:46-48). The option provided to the user of the class C mobile station is “[b]efore executing the GPRS LOGON functionality, the [mobile station] may activate ‘Bar all incoming calls’ or may activate ‘Call forwarding unconditional.’ Alternatively, ‘User defined user busy’ functionality is adapted from the call forwarding functionality.” (Gilchrist, col. 4:13-17).

The Office Action relies on Hays as teaching “data transmission in a mixed mobile cellular/paging radio system . . . whereby the system can identify a mobile user as a hybrid phone/pager device and subsequently can send a data message via voice channel and/or pager channel which reads on determining whether the mobile is a hybrid station” (Office Action, p. 3, ¶ 6). But it is respectfully submitted that the page of Hays is a content message, not a page signal. (Hays, p. 7, ll. 1-5) (“The page message can be, for example, a short message, such as an indication that a message is waiting or an instruction to turn on the mobile telephone, or a longer message, such as a data message sent by a caller.”). Further, it submitted that the determination of whether the data could be sent to the mobile station of Hays is with respect to the network access, not to mobile station characteristics. (see Hays, Abstract and Summary of Invention, pp. 2-4).

Accordingly, Applicant respectfully submits that there has not been a *prima facie* showing that substantiates the rejection of Applicant’s claimed invention. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Gilchrist and Hays to achieve Applicant’s claimed invention as set out in Independent Claims 1 or 8, and claims 2 and 4-5 that depend, directly or indirectly, from Claim 1, or claims 9-10 and 12-14 that depend, directly or indirectly, from Claim 8. Applicant respectfully requests that the rejection to these claims be withdrawn.

Applicant also recites a “method in a base station for routing or setting up a call, comprising: examining a permanent ID of a mobile station for which a voice call is to be set up; and determining whether the mobile station is a hybrid mobile station.” (Independent Claim 15).

With respect to Applicant’s invention of Independent Claim 15, Gilchrist does not suggest the “examining a permanent ID of a mobile station . . . and determining whether the mobile station is a hybrid mobile station.” Instead, Gilchrist refers to the use of busy status of a class C mobile station, which cannot be interrupted (*see* Gilchrist, col. 1:46-48), or allowing the use of text page content messaging with a class B mobile station (*see, e.g.,* Gilchrist, col. 6:45-50). Further, Hays refers to the determination of whether the data could be sent to the mobile station of Hays is with respect to the network access, determination of mobile station characteristics as in Applicant’s claimed invention. (*see* Hays, Abstract and Summary of Invention, pp. 2-4).

Accordingly, Applicant respectfully submits that there has not been a *prima facie* showing that substantiates the rejection of Applicant’s claimed invention. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Gilchrist and Hays to achieve Applicant’s claimed invention as set out in Independent Claims 15, or to claims 16 and 19-20 that depend directly or indirectly therefrom. Applicant requests that the rejection to these claims be withdrawn.

(b) Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilchrist and Hays as applied to claim 2 and further in view of Kari WO97-26764 (“Kari”). Claims 6-7, 11 and 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilchrist and Hays as applied to claim 2 and further in view of Kari.

Applicant respectfully traverses these rejections, and requests reconsideration of its claims.

Claims 3 and 6-11 depend, either directly or indirectly, from Independent Claim 1. Claim 11 depends from Independent Claim 8. Claims 17-18 depend from Independent Claim 15.

These dependent claims take on the limitations of the claims that they depend from. Accordingly, for the reasons that Gilchrist in view of Hays does not substantiate a *prima facie* case for an obviousness rejection as discussed above, these claims are similarly allowable. Accordingly, as there is no showing of a *prima facie* showing of obviousness for the Independent Claims that these claims depend from, there similarly is no showing with respect to these claims in view of Gilchrist and Hays, or for those additional references cited in the Office Action in its rejection.

Kari recites a “basic idea of the present invention is to produce information for the actual mobile communication network on that it is not completely certain that the mobile station is available for conventional calls when the mobile station is in the packet radio state.” (Kari, p. 6, ll. 23-27).

Applicant notes that in the explanation of its rejection to Claims 6-7, 11, and 17-18, the Office Action refers to Shtivelman (U.S. 6,078,581), but has not provided this reference as a basis of the obviousness rejection. Presuming that the Shtivelman reference was intended in the Office Action rejection of dependent claims 6-7, 11 and 17-18, and not Kari, Applicant will address the Shtivelman reference accordingly.

Shtivelman recites that it “pertains more particularly to apparatus and methods for providing call waiting services for what are known as Internet Phone (IP) calls.” (Shtivelman, col. 1:5-7). The embodiment Shtivelman recites is an “IP interface connected to both the PSTN and the Internet. During time that the status indicator indicates the client is Internet-connected, on receiving a PSTN call directed to the client, the system sends, via the IP interface, an alert signal of a call waiting to an IP address associated with the client.” (Shtivelman, col. 2:40-44).

As stated above with respect to Gilchrist and Hays, there is no suggestion or motivation in either of those references to achieve Applicant’s claimed invention, as discussed above.

The addition of Kari, with respect to the rejection of dependent claim 3, was cited as “[teaching] a hybrid mobile supporting both voice and data communications whereby the

system can determine if the mobile is involved in a voice or data call and signal the other service to hold, call forward, end call and connect to other service, etc. (Abstract, Figure 1, Independent Claims).” (Office Action, p. 8, ¶ 6). Kari, however, refers to the use of class B and class C mobile stations in that “the GPRS GSM network there may be mobile stations MS (class B or C mobile stations) which may be either in the GPRS state or in the GSM state (data or speech transmission over a circuit-switched connection).” (Kari, p. 13, *ll.* 24-28). Kari simply advises the network as to a GPRS mobile station’s unavailability. (Kari, p. 14, *ll.* 19-22). In this regard, it is respectfully submitted that there is no suggestion or motivation to combine Gilchrist in view of Hays, and further in view of Kari, to achieve Applicant’s claimed invention of dependent Claim 3.

Claims 6-7 depend, directly or indirectly, from Independent Claim 1. Claim 11 depends from Independent Claim 8. Claims 17-18 depend, directly or indirectly, from Independent Claim 15.

As stated above with respect to Gilchrist and Hays, there is no suggestion or motivation in either of those references to achieve Applicant’s claimed invention, as discussed above.

Shtivelman was cited as “[teaching] Internet call waiting . . . and use of a cellular phone in the application of call waiting (C5, L56 to C6, L13).” (Office Action p. 9, ¶ 3). The terminals of Shtivelman, however, are for “providing call waiting services for what are known as Internet Phone (IP) calls,” (Shtivelman, col. 1:5-7). In this regard, it is respectfully submitted that there is no suggestion or motivation for combining Gilchrist in view of Hays, and further in view of Shtivelman, to achieve Applicant’s claimed invention in dependent Claims 6-7, dependent claim 11, or dependent claims 17-18. It is further respectfully submitted that the Office Action relies on Applicant’s disclosure for the suggestion or motivation for the combination proffered.

Accordingly, for the reasons stated above with respect to the hypothetical combination of Gilchrist in view of Hays, and the further combination in view of Kari or in view of Shtivelman as stated in the Office Action, there is no suggestion or motivation leading one of ordinary skill in the art to combine these references to achieve Applicant’s

claimed invention, thus a *prima facie* showing of obviousness has not been established. It is respectfully submitted that dependent claims 3, 6-7, 11 and 17-18 are allowable, and requests that the rejections be withdrawn.

3. CONCLUSION

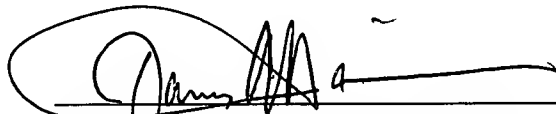
As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jharrison@texaspatents.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 502126.

Respectfully submitted,

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